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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,382	07/30/2003	Douglas Swingley	14442-1	9565

7590

11/16/2005

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EXAMINER

HOOK, JAMES F

ART UNIT PAPER NUMBER

3754

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,382

Applicant(s)

SWINGLEY, DOUGLAS

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, and 16 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Applicant sets forth in the declaration executed on January 27, 2005 in paragraphs 5 and 8, that the fittings and pipe for DWV service as claimed in the present application were sold by Spears Manufacturing Company “for little more than three years”. The instant application was filed on July 30, 2003, and was a continuation of a provisional application filed on March 26, 2003. Therefore, if the claimed product was on sale for a little more than three years from January, 27, 2005 then it was on sale at least by January 27, 2002 which is approximately 1 year and 2 months prior to the filing of any application. Since applicant is swearing under penalty of perjury that all statements are true, and has set forth that the claimed article was on sale for little more than three years from the date of the signing of the declaration, then such is considered adequate proof that such was on sale to the public more than one

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year prior to the filing of any US application. CPVC is known to inherently be joined by solvent cement.

Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Chemdrain (892-ref U). The Chemdrain reference states that it is old and well known in the art, to form chemical processing pipes of CPVC for over thirty (30) years, and that the benefits of CPVC are known, can be assembled using solvent or cement, and was used in a variety of chemical processing piping systems of which DWV is known inherent piping uses in processing plants. The use of such for carrying certain chemicals is merely intended use and the CPVC pipe is capable due to the material properties of CPVC of carrying the recited chemicals as such is an inherent property of the material and merely intended use.

Claims 1-4 ,13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuohey. The patent to Tuohey discloses the recited drain fitting 28 which is formed of a material said to be PVC where the specification designates the use of PVC to include all forms of PVC including chlorinated polyvinyl chloride (CPVC), where the water and debris carried by the gutter is considered waste, and where the fitting is used with other CPVC pipe components. The use of the term DWV is considered to be merely intended use of the fitting and the fitting of Tuohey is capable of use as a drain and therefore as a DWV also in that it is used as a drain. It is also disclosed that all components of the system are made of PVC of which CPVC is a known type of PVC

used, thereby teaching the combination of a combination of fittings and pipe, such as pipe 38 and fitting 28.

Claims 1-4, 6, and 13, 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Vanesky (577). The patent to Vanesky discloses the recited drain fitting 22 which is formed of a material such as ABS, PVC, or CPVC, where the fittings are used in home water drains which inherently would include sanitary waste, and where the fitting is used with other CPVC pipe components. The use of the term DWV is considered to be merely intended use of the fitting and the fitting of Vanesky is capable of use as a drain as set forth and therefore as a DWV also in that it is used as a drain. Vanesky also discloses that the pipe connections are made with solvent cement, and it is an inherent property of CPVC as well as merely intended use where CPVC piping is capable of carrying different waste fluids.

Claims 1-7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaefer (542). The patent to Shaefer discloses the recited pipe fitting 10 which is formed of a material such as PVC or CPVC, where the fittings are used for fluid passages where the fluid is known to contain acids where CPVC exhibits a high degree of chemical resistance to acids, and where the fitting is used with other CPVC pipe components. The use of the term DWV is considered to be merely intended use of the fitting and the fitting of Shaefer is capable of use as a drain. The use of Shaefer in systems that would be exposed to acids suggests that the fittings therefore are used in some manner to inherently carry materials such as industrial process waste or sanitary waste, and most certainly acid waste when such is formed of CPVC.

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Auvil (378). The patent to Auvil discloses the recited combination of a pipe and fitting which are made of CPVC. The use of the term DWV is considered to be merely intended use of the fitting and the fitting of Auvil is capable of use as a drain and therefore as a DWV.

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Thomas. The patent to Thomas discloses the recited combination of a pipe and fitting which are made of CPVC which is used as a drain. The use of the term DWV is considered to be merely intended use of the fitting and the fitting of Thomas is capable of use as a drain as set forth and therefore as a DWV also in that it is used as a drain.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Condon in view of Shaeffer (542). The patent to Condon discloses the recited DWV pipe fitting 66 formed of PVC or ABS. The patent to Condon discloses all of the recited structure with the exception of forming the fitting of CPVC for use in various waste drains. The use of the DWV fitting to handle various types of waste is considered to be an inherent ability of the material used and a teaching of the use of CPVC is considered to be teaching a material capable of carrying all the types of waste listed in the claims in that the material is the same as used by applicant and would

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inherently be usable for the same types of applications as such is merely intended use, and CPVC is inherently known to be connected using solvent cements. The patent to Shaeffer teaches the use of CPVC as an equivalent material used in where PVC is used in fittings to provide chemical resistance to acids and other materials. It would have been obvious to one skilled in the art to modify the DWV fitting in Condon by substituting CPVC for PVC to allow the fitting to be used in drains that would be exposed to acids or other dangerous materials as suggested by Shaeffer as such would lengthen the life of the fitting due to the improved properties of CPVC in acidic uses.

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaeffer (542). The patent to Shaeffer discloses all of the recited method with the exception of using the fitting for specific types of waste, however, it is noted that Shaeffer discloses the use of the fitting for various materials and inherently the use of CPVC would be capable of use to carry other types of acidic wastes because such is merely a feature of the material used, and a choice of mechanical expedients to use the fitting for other types of acidic materials, therefore it would have been obvious to one skilled in the art to use the fitting in Shaeffer for any type of acidic material including various types of acidic waste as such is merely a choice of mechanical expedients.

Response to Amendment

The declaration to Piper under 37 CFR 1.132 filed November 7, 2005 is insufficient to overcome the rejection of claims 1-14 based upon the references as set forth in the last Office action because: such claims were rejected under anticipation and

not obviousness, and for such to be sufficient for the case of obviousness the declaration needs to address the claims with respect to the references and why the combination of references is non-obvious.

The declaration to Peak under 37 CFR 1.132 filed November 7, 2005 is insufficient to overcome the rejection of claims 1-14 based upon the statutory bar for public sale and commercial success as set forth in the last Office action because: many of the claims are rejected under anticipation and not obviousness, which is the only applicable argument for commercial success, and there is insufficient evidence provided that the previous declaration setting forth that the claimed invention was sold more than one year prior to filing of the application was in error when someone swore in a declaration this information was true, more than just a statement that it was not sold till a certain date is not enough to refute the authenticity of the previous declaration, therefore more proof of sale is required.

The declaration under 37 CFR 1.132 filed February 2, 2005 is insufficient to overcome the rejection of claims 1-13 based upon Condon in view of Shaeffer, or claims 8-12 based upon Shaeffer as set forth in the last Office action because:

It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. The declaration only contains discussion of the use of CPVC in DWV

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fittings, however, there is no nexus between the obviousness rejections and the statements being made with respect to showing evidence that is commensurate with the scope of the claims in question, but rather is a general statement.

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. The declaration sets forth in item 7 that those skilled in the art were working at one time with the material and found it to be unsatisfactory, however, there is no suggestion of how long they were working on it, and there is no evidence that if the persons skilled in the art who were presumably working on the problem knew of the teachings of the cited references. There also appears to be suggestion to the contrary that those skilled in the art new of the use of CPVC for use in fittings for DWV fittings such as is evidenced by the patent to Vanesky (577).

In general the declaration attempts to address commercial success, however, it has not set provided evidence that such success was not afforded based on other factors such as cheaper pricing than other materials. The obviousness rejection shows proof that the material was known for such uses as fittings, the declaration does not exclude other factors such as pricing that may have affected sales results, and based upon paragraph 8, it is suggested that the actual cheapness may have been a factor in the success of the product. This appears to be contradicted in paragraph 11 which

states there are no extraneous factors, however, pricing is considered an extraneous factor which could lead to success above other more expensive choices of materials.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive. With respect to the declaration, such is only applicable toward the rejections under 35 USC 103, commercial success cannot overcome rejections under anticipation. With respect to copying by others, such is also only applicable to obviousness type rejections, and not pertinent when anticipatory references exist, and the alleged infringer states they have been making pipe for 30 years of CPVC for this same environment which is a statutory bar. The same is true of recognition by competitors which only exists in cases of obviousness and arguments have to be directed toward the features being combined in the obviousness rejection. The same is once again true with respect to long felt need. With respect to the bar for public sale as mentioned above more information is needed to prove the previous declaration is false, and that false statements were sworn to. With respect to the rejections under Tuohey, Vanesky, and Shaefer (542), the intended use of an article when such is capable of the intended use, is applicable in this case especially when many of the references refer to drain pipes which would fall under a DWV fitting in that they are drains which is what the D stands for. Applicant acknowledges by using the term "use of DWV fittings and systems" on page 4, that such is the use of the fitting claimed. The term DWV does not

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offer any structure to the claim language, but rather is a description of use of the fitting being claimed in the preamble which breathes no life into the limited structure set forth in the body of the claim. Therefore, it would hold no patentable weight even if such were considered to be more than just intended use. The term has not been set forth in the specification to include all of the limitations set forth in the arguments toward these references. It is considered that drain pipes would have the same structure as DWV fittings, and applicants argument that the prior art has no fall is not persuasive when such is not only not a claimed feature of the article, but also is more detailed than the claim language where the fall appears to be directed toward tee branch fittings, where applicant's language is directed toward a fitting in general and could take many shapes, and therefore the arguments are more detailed than the claim language with respect to these references used under 35 USC 102. With respect to the 103 rejection in regards to the teachings from the declaration, the declaration is provided to teach commercial success, such is not considered evidence that CPVC is unsuitable for use with DWV fitting, and such is actually contrary to the teachings of applicant. The modifying reference teaches the equivalence of using CPVC in place of PVC in fittings for pipes and therefore provides the motivation to combine the references regardless of whether or not it was considered to be suitable by those skilled in the art, the prior art itself teaches that one can expect success of using CPVC in place of PVC for pipe fittings. There is no evidence provided that any tests were done by those skilled in the art to show that there would be no success of using CPVC because of seal problems, and in light of the evidence set forth in Vanesky (577) which was patented on November 11,

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1997 that an adequate seal could be attained by forming fittings of CPVC and using such as drain pipes even in situations such as laboratories (col. 7, lines 1-5). For these same reasons the arguments against Shaefer are equally not persuasive. As set forth above, the declaration is not sufficient to teach commercial success, and therefore such is not a persuasive argument for the reasons set forth above. It is further noted that Condon which is described by applicant as proof of the meaning of DWV fittings and the definition of such in the art, it is noted that Condon clearly discloses DWV fittings and states that such can be formed with 90 degree angles, therefore the arguments that the prior art rejections above show 90 degree elbows which have no fall and therefore are not DWV fittings is not persuasive, and that DWV term cannot be limited to features such as fall, unless such is actually placed in the claim language as a positive limitation. With respect to new claim 14, such is moot based upon the rejections set forth above which were required by the addition of this new claim. The remaining arguments are not directed toward specific errors in the rejection and support within the patents that these errors exist.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Parhar disclosing state of the art fittings and DWV pipes some made of CPVC.

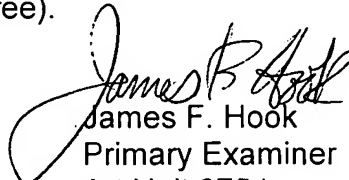
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-

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4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James F. Hook
Primary Examiner
Art Unit 3754

JFH